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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/502,664 02/11/00 VALE

R REGEN1500-1

HM22/0724

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EXAMINER

PADMANABHAN, K

ART UNIT

PAPER NUMBER

1641

DATE MAILED:

07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.		Applicant(s)	
	09/502,664		VALE ET AL.	
	Examiner		Art Unit	
	Kartic Padmanabhan		1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-103 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a method of isolating a polypeptide of interest, classified in class 435, subclass 4.
 - II. Claims 13-23 and 35-37, drawn to a DNA construct, classified in class 435, subclass 7.1.
 - III. Claims 24-34 and 74-76, drawn to another DNA construct, classified in class 435, subclass 6.
 - IV. Claims 38-45, drawn to another method of isolating a polypeptide of interest, classified in class 436, subclass 518.
 - V. Claims 46-56, drawn to another method of isolating a polypeptide of interest, classified in class 436, subclass 800.
 - VI. Claims 57-73, drawn to a kit comprising a modified F1AsH compound, classified in class 435, subclass 287.1.
 - VII. Claims 77-87, drawn to another method of isolating a polypeptide of interest, classified in class 436, subclass 824.
 - VIII. Claims 88-98, drawn to another method of isolating a polypeptide of interest, classified in class 436, subclass 177.
 - IX. Claims 99-103, drawn to a modified F1AsH compound, classified in class 436, subclass 86.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, groups I, IV, V, VII, and VIII are all different methods of isolating a polypeptide of interest. However, the steps involved and /or the structure of the polypeptides in the five methods all differ from each other. In addition, groups II and III differ from each other in that they are different DNA constructs that differ in structure at their 5' and 3' ends. These DNA constructs also are distinct from the methods of groups I, IV, V, VII, and VIII because none of the methods require the DNA constructs of groups II or III. Furthermore, the kit of group VI is unrelated to the other eight groups because the kit may be used with methods other than those claimed for isolating a polypeptide and does not require a DNA construct. Finally, the compound of Invention IX is unrelated to groups I-VIII, as the compound is not required of any of the methods, the DNA constructs, or the kit.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and the search required for one group is not required of the others, restriction for examination purposes as indicated is proper.

4. If applicant elects groups I, IV, V, VI, VII, or VIII, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

a) If groups I, IV, V, VII, or VIII is elected, applicant must select one of the claimed solid supports of claims 8, 41, 50, 83, or 92, respectively.

b) If group VI is elected, applicant must select one of the claimed solid supports in claims 62 and 67.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kartic Padmanabhan whose telephone number is 703-305-0509. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5207 for regular communications and 703-305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Kartic Padmanabhan
Patent Examiner
Art Unit 1641

*** *KP*
July 19, 2001

Christopher L. Chin
CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800 /641